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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Michel BESSODES *et al.*)
)
Application No.: 09/972,854) Group Art Unit: 1623
)
Filed: October 10, 2001) Examiner: Traviss C. McIntosh, III
)
For: ACID-SENSITIVE COMPOUNDS,)
THEIR PREPARATION AND)
USES)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENT

In reply to the written Restriction and Election of Species Requirement, mailed June 2, 2003, Applicants submit the following response.

The Office has required restriction under 35 U.S.C. § 121 to one of the following groups of claims:

- Group I** Claims 1-12, 15-18, and 21-29, drawn to an acid-sensitive compound or composition;
- Group II** Claims 13 and 14, drawn to an acid sensitive compound where various G-groups are linked via a spacer;
- Group III** Claims 19 and 20, drawn to a composition comprising the acid sensitive compound of Group I with a biologically active substance;

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Group IV Claims 30-33, drawn to a method of treating a disease or disorder;
and

Group V Claims 34-38, drawn to a method of transfecting a nucleic acid.

Office Action, page 2.

At the onset, Applicants point out that they filed a Preliminary Amendment on November 12, 2002, canceling claims 1-16 and 30-38. Applicants enclose a copy of that Amendment and a date-stamped postcard indicating its receipt by the Office. Accordingly, claims 17-29 are pending in this application.

In view of this amendment, the claims in Groups II, IV, and V have been canceled as they encompass canceled claims. The pending claims fall within Group I (claims 17, 18, and 21-29) III (claims 19 and 20).

Applicants elect, with traverse, **Group I**, claims 17-18, and 21-29, drawn to a composition comprising an acid-sensitive compound.

The Office contends that the inventions of Groups "I, II, and III are all multiple compounds or compositions all having independently different structures." (Office Action, page 2.) The Office's position is that restriction is proper because a search required for one invention is allegedly "not required for all inventions." (*Id.*, page 3.) Applicants disagree.

Applicants traverse the restriction requirement on the grounds that the Office has not shown that there would be a serious burden to examine the claims of Groups I and III together. This serious burden is one necessary criterion for a restriction requirement. M.P.E.P. § 803. Applicants respectfully submit that a search of the subject matter of Group III, in addition to the subject matter of Group I, would not be burdensome

because a search of the subject matter of Groups III should encompass the search of the subject matter of Group I since all claims recite an acid-sensitive compound encompassed by formula (I). Applicants note that the Office does not contend that the subject matter falls into distinct classes or subclasses. Accordingly, Applicants respectfully request that the Office examine claims 17-29 together in this application.

In addition, the Office requires Applicants to elect a single disclosed species for prosecution on the merits and identify the claims readable on the elected species, including any claims subsequently added. Office action, page 4.

Applicants elect, with traverse, "**Compound C**" disclosed in the specification at page 53, lines 7-8. At least claims 17-29 read on the elected species. In regards to claim 17, the elected species comprises a hydrophilic substituent that is a polyalkylene glycol. In regards to claim 18, the elected species is encompassed by at least paragraph (d) of claim 18; and wherein "G" is hydrogen.

Applicants traverse the election of species requirement on the grounds that the Office has not shown that there would be a serious burden to examine the full scope of claims 17-29. Applicants respectfully request that the full scope of the claimed invention be examined in this application without an election requirement. If the Office chooses to maintain the election requirement, however, and should the elected species be found allowable, Applicants expect the Office to continue to examine the full scope of the claimed subject matter to the extent necessary to determine the full scope of the patentability thereof, *i.e.*, extend the search to the non-elected species, such as the other hydrophilic groups of claim 17 reading on non-elected species, as required. *See* MPEP § 803.02 and 35 U.S.C. § 121.

If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, he is invited to call Applicant's undersigned representative at 202-408-4128.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 2, 2003

By: 

Charles D. Niebylski
Reg. No. 46,116

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